UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,251	10/16/2001	Balamani S. Vishwanath	64423-00040	5985

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EXAMINER
CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/981,251	VISHWANATH ET AL.
	Examiner	Art Unit	
	Mary Cheung	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 May 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *March 1,04*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on May 21, 2004. Claims

1-18 are pending. Claims 1-10 have been amended.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

3. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter.

As to claims 1-18, the claimed system comprises only the software, such

as "at least one authentication software product", "a security architecture

software", "a profile application software", etc. Although these software are

functional descriptive material, the claims are directed to non-statutory subject

matter because they are not embodied in computer-readable medium. See

MPEP 2106 IV B 1(a).

Response to Arguments

4. Applicant's arguments filed May 21, 2004 have been fully considered but they

are not persuasive.

Applicant argues that Alegre (U. S. Patent 6,199,113) fails to teach "the at

least one authentication software product is capable of servicing at least one

external source" as claimed in claim 1. Examiner respectfully disagrees because

the authentication server in Alegre's teaching can provide authentication service

for external sources, such as the client browser, the web host, etc. (column 4

lines 25-42 and Fig. 2).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102

that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-6, 8, 10 and 18 are rejected under 35 U.S.C. 102(e) as being

anticipated by Alegre et al., U. S. Patent 6,199,113.

As to claim 1, Alegre teaches a system for user identity management and

software product distribution comprising (abstract and column 4 lines 25-42 and

Fig. 2):

a) At least one authentication software product (column 4 line 25-42 and

Figs. 2, 9; *specifically, "at least one authentication software product"*

corresponds to the authentication software process used by the

authentication server in Alegre's teaching);

b) A security architecture software capable of protecting the system (Fig.

2);

c) Wherein the at least one authentication software product is capable of

servicing at least one external source (column 4 lines 25-42 and Fig. 2).

As to claim 2, Alegre teaches a profile application software capable of maintaining an online electronic profile for each external source wherein the profile application software is accessible by external source system users and end users (column 4 lines 25-42 and column 6 lines 31-33 and Fig. 2; *specifically, the profile application software corresponds to user access profile*).

As to claim 3, Alegre teaches the product comprises a series of platform-independent servlet based application (column 8 lines 54-65; *"servlet" is portable small software application based on object oriented program, such as Java, thus, the "Java applets" in Alegre's teaching satisfies this limitation*).

As to claim 5, Alegre teaches the security architecture software is capable of encrypting of transmitted data for security against spoofing (column 7 lines 32-35).

As to claim 6, Alegre teaches the system is capable of keep tracking of each authentication software product devices and ownership/assignments to a plurality of external access sources and their end users (column 6 lines 65-67 and column 8 lines 28-35).

As to claim 8, Alegre teaches an autonomous, stand-alone application using the system of claim 1 wherein the authentication software product is capable of providing user authentication and access control as separate functions autonomous from the system of claim 1 (column 4 lines 25-42 and column 5 lines 48-58 and Figs. 2, 5; *specifically, "an autonomous, stand-alone application" corresponds to the web server as shown in Fig. 5*).

As to claim 10, Alegre teaches an autonomous application using the

system of claim 1, wherein the system is capable of being deployed completely

on a client's site, wherein the client comprises a client server, in which the client

server is capable of functioning as a server application independent of the

system of claim 1 (column 4 lines 25-30 and column 5 lines 8-20, 48-58 and Figs.

2-3, 5; *specifically, "client server" corresponds to the web server as shown in*

Figs. 2, 5).

As to claim 18, Alegre teaches the system is capable of managing and

tracking specific and group end-user access authorizations to digital content and

process for each external source (column 6 lines 65-67 and column 8 lines 28-35

and Fig. 14).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

8. This application currently names joint inventors. In considering patentability

of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject

matter of the various claims was commonly owned at the time any inventions

covered therein were made absent any evidence to the contrary. Applicant is

advised of the obligation under 37 CFR 1.56 to point out the inventor and

invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35

U.S.C. 103(a).

9.   Claims 4, 9 and 11-17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Alegre et al., U. S. Patent 6,199,113 in view of Pearce et al.,

U. S. Patent 6,243,468.

As to claim 4, Alegre teaches the security architecture software is capable

of automatic encoding of transmitted data (column 7 lines 32-35). Alegre does

not specifically teach encoding transmitted data using unique hashing routines.

However, Pearce teaches encoding transmitted data using unique hashing

routines (column 6 lines 41-47 and Fig. 2). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to allow the

transmitted data in Alegre's teaching to be encoded using unique hashing

routines for better protecting the transmitted data from piracy.

As to claim 9, Alegre teaches the autonomous, stand-alone application,

and protecting the transmitted data as discussed above. Alegre does not

specifically teach the at least one authentication software product and the

security architecture software are capable of providing software piracy

management to software manufacturers distributing application product via CD-

ROM or a wide area network. However, Pearce teaches authentication product

and security architecture are capable of providing software piracy management

to software manufacturers distribution application product via CD-ROM or a wide

area network (column 1 line 66 – column 2 line 8 and column 3 line 66 – column

4 line 10, 21-25 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the authentication product and the architecture in Alegre's teaching to include the feature of capable providing software piracy management to software manufacturers distribution application product via CD-ROM or a wide area network for conveniently distributing the transmitted data and better protecting the transmitted data from piracy.

As to claims 11-16, Alegre teaches a system for securely distributing software as discussed above. Alegre does not specifically teach the system is capable of reading CD-ROM content remotely via a wide area network, providing CD media-based copy protection, validating the CD media, providing CD media authentication remotely via a wide area network, providing embedded, encrypted serialization of CD media, providing anti-piracy protection to electronic distributed software, and using CD media developed with anti-piracy technology as effective user authentication devices. However, Pearce teaches this matter (column 1 line 66 – column 2 line 8 and column 3 line 66 – column 4 line 10, 21-26 and column 5 lines 20-45 and column 7 lines 8-40 and Figs. 1-2, 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system in Alegre's teaching to include the features of reading CD-ROM content remotely via a wide area network, providing CD media-based copy protection, validating the CD media, providing CD media authentication remotely via a wide area network, providing embedded, encrypted serialization of CD media, providing anti-piracy protection to electronic distributed software, and

using CD media developed with anti-piracy technology as effective user

authentication devices because this would allow the distributed software to be

conveniently and securely delivered to users, and at meanwhile, it also prevents

software piracy.

As to claim 17, Alegre teaches a system for securely distributing software

as discussed above. Alegre does not specifically teach the system is capable of

bundling full products and license packs on at least one CD-ROM. However,

Alegre teaches bundling full products and license packs on a CD-ROM (column 1

line 66 – column 2 line 8 and Fig. 1). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to allow the system in

Alegre's teaching to include the feature of bundling full products and license

packs on a CD-ROM because this would allow the products and their associated

information to be conveniently delivered to users.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alegre

et al., U. S. Patent 6,199,113 in view of Reardon, U. S. Patent 6,212,635.

As to claim 7, Alegre teaches the authentication software product

comprising:

a) A username (column 4 lines 25-40; *specifically, "username"*

corresponds to user ID);

b) A password (column 4 lines 25-40);

c) An authentication device (column 4 lines 25-40; *specifically,*

"authentication device" corresponds to authentication server);

d) Wherein the authentication device is selected from group consisting of software token (column 4 lines 25-31).

Alegre does not specifically teach the authentication device is selected from group consisting of key chain tokens, and tokens capable being read by a Smart Card Reader. However, this matter is taught by Reardon as an authentication device is selected from group consisting of key chain tokens, and tokens capable being read by a token reader (column 9 lines 54-65 and column 17 lines 36-40 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the authentication device in Alegre's teaching to include key chain tokens, and tokens capable being read by a token reader as taught by Reardon for better protecting the authentication product from authorized access.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Mary Cheung whose telephone number is

(703)-305-0084. The examiner can normally be reached on Monday – Thursday

from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate

Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application

or proceeding should be directed to the receptionist whose telephone number is
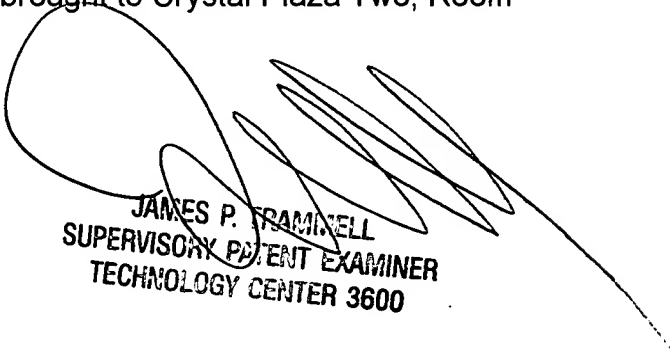
703-308-1113.

The fax phone number for the organization where this application or

proceedings is assigned are as follows:

(703) 872-9306   (Official Communications; including After Final

Communications labeled "BOX AF")

(703) 746-5619   (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room

1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
August 17, 2004

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